UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,141	10/31/2003	James Howard Drew	03-8012	3441

25537 7590 10/13/2011

VERIZON
PATENT MANAGEMENT GROUP
1320 North Court House Road
9th Floor
ARLINGTON, VA 22201-2909

EXAMINER	
STERRETT, JONATHAN G	

ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
10/13/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES HOWARD DREW and HUI LIU

Appeal 2010-010725
Application 10/699,141
Technology Center 3600

Before: HUBERT C. LORIN, MEREDITH C. PETRAVICK, and MICHAEL W. KIM, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 3, and 5-34. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods related to performance measurement, and more particularly to productivity indices or metrics for comparing employees performing differing tasks (Spec., para. [0001]). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A computer implemented method of determining comparable performance measures for employees having differing task assignments, comprising:
>
> storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task;
>
> generating sets of task scores based on a selected model design of task assignments utilizing said employee task data;
>
> selecting a centralized composite design as said model design;
>
> performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores;
>
> analyzing said productivity scores to determine productivity parameters, wherein analyzing said productivity scores comprises applying linear regression techniques to said productivity scores utilizing said computing system; and
>
> applying said productivity parameters to employee task scores for said employees to obtain said performance measures for said employees.

Claims 1, 3, and 5-28 stand rejected under 35 U.S.C. § 101 for failing to recite statutory subject matter; claims 1, 3, 5, 8-19, and 22-32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over various instances of

the Examiner's Official Notice in view of Philip L. Roth, et al., *A Research Agenda For Multi-Attribute Utility Analysis in Human Resource Management*, 7 Human Res. Mgmt. Rev. 341-68 (1997) (hereinafter "Roth"), Jeffrey R. Edwards, et al., *On the Use of Polynomial Regression Equations as an Alternative to Difference Scores in Organizational Research*, 36 The Academy of Mgmt. Journal, 1577-1613 (Dec. 1993) (hereinafter "Edwards"), and Linda Trocine, et al., *Finding Important Independent Variables Through Screening Designs: A Comparison of Methods*, Proceedings of the 2000 Winter Simulation Conference, 749-54 (2000) (hereinafter "Trocine"); and claims 6-7, 20-21, and 33-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over various instances of the Examiner's Official Notice in view of Roth, Edwards, Trocine, and Tom Jacobson, 22 *Credit Union Mgmt. Madison*, 50 (Jun. 1999) (hereinafter "Jacobson").

We AFFIRM-IN-PART and enter a NEW GROUND of rejection under 37 C.F.R. § 41.50(b).

ISSUES

Did the Examiner err in asserting that independent claims 1 and 22 are not directed to statutory subject matter under 35 U.S.C. § 101? The issue turns on whether "computer implemented method," "storing employee task data in a database of a computing system," and "applying linear regression techniques utilizing a computing system" constitute sufficient structure to render the process statutory.

Did the Examiner err in asserting that a combination of various instances of the Examiner's Official Notice, Roth, Edwards, and Trocine

render obvious performing "a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores," as recited in independent claims 1, 22, and 29?

ANALYSIS

101 Rejection

We are not persuaded the Examiner erred in asserting that independent claims 1 and 22 are not directed to statutory subject matter under 35 U.S.C. § 101 (App. Br. 20-21; Reply Br. 2-3). The Supreme Court recently reaffirmed that abstract ideas are not patentable subject matter. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3229 (2010) ("[i]n searching for a limiting principle, this Court's precedents on the unpatentability of abstract ideas provide useful tools"). With the exception of the recitations of "computer implemented method" and "computing system," independent claims 1 and 22 recite unpatentable abstract ideas in the form of pure mental steps. *See In re Abrams*, 188 F.2d 165, 168 (CCPA 1951) ("[c]itation of authority in support of the principle that claims to mental concepts which constitute the very substance of an alleged invention are not patentable is unnecessary. It is self-evident that thought is not patentable"). Accordingly, the question is whether the aforementioned computer recitations are sufficient to render the otherwise unpatentable abstract ideas into statutory subject matter.

Appellants assert that the recitation of a "computer implemented method" in the preamble renders the process statutory (App. Br. 20; Reply Br. 2). However, the mere recitation of a computer in the preamble is a field-of-use limitation that is insufficient to render an otherwise patent-ineligible process patent-eligible. *See Diamond v. Diehr*, 450 U.S. 175, 191

(1981). *Cf. SiRF Tech., Inc. v. Int'l Trade Comm'n*, 601 F.3d 1319, 1333 (Fed. Cir. 2010). Furthermore, in *Bilski*, the Supreme Court approvingly cited *Flook* for "the proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.'" *See Id.* at 3230. Accordingly, attempting to limit the abstract ideas of independent claims 1 and 22 to a computer environment, as Appellants attempt to do here in the preamble, is insufficient to render it statutory.

Appellants then assert that "storing employee task data in a database of a computing system" renders the process statutory (App. Br. 20; Reply Br. 2). However, the Supreme Court in *Bilski*, again approvingly citing *Flook*, stated that "the proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by... adding 'insignificant postsolution activity.'" *See Id.* at 3230. The mere storing of data is just such an extra-solution activity insignificant to the core of the invention, and thus is disfavored by *Bilski* and *Flook*. To hold otherwise would allow Appellants to easily circumvent the unpatentability of abstract ideas by merely storing it on a computer, rendering superfluous the prohibition against patenting abstract ideas.

Appellants then assert that "applying linear regression techniques utilizing a computing system" renders the process statutory (App. Br. 20-21; Reply Br. 2-3). However, the linear regression is an abstract idea that can be performed purely as mental steps, and "utilizing a computing system" to perform the linear regression is a field-of-use limitation to a particular technological environment insufficient to render it statutory. Moreover, the phrase "utilizing a computing system" is extremely broad, as arguably a user

could just use the computing system in a *de minimis* manner, such as a like a calculator, while mentally performing the bulk of the linear regression. In such a case, "utilizing a computer system" in the linear regression would be no more than an extra-solution activity that is disfavored in *Bilski*.

Insofar as our rationale differs from that set forth by the Examiner, we denominate it a new ground under 37 C.F.R. § 41.50(b).

103(a) Rejections

We are persuaded the Examiner erred in asserting that a combination of various instances of the Examiner's Official Notice, Roth, Edwards, and Trocine render obvious performing "a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores," as recited in independent claims 1, 22, and 29 (App. Br. 28-29; Reply Br. 7-8). The Examiner asserts that the respective 134 and 168 points generated for the cognitive ability test and the interview, as set forth on page 343 of Roth, correspond to the recited task scores (Exam'r's Ans. 5, 8, 35-36). The Examiner then asserts, however, that these same points also correspond to the recited productivity scores (Exam'r's Ans. 5, 8, 39). However, as independent claims 1, 22, and 29 each recite that the task scores are used to assign the productivity scores, the task scores and the productivity scores cannot be the same value, as asserted by the Examiner. *See Texas Instr. Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (claim language cannot be mere surplusage. An express limitation cannot be read out of the claim); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991) (two distinct claim elements should each be given full effect). Accordingly, we do not sustain the §

103(a) rejections of independent claims 1, 22, and 29, or their dependent claims 3, 5-21, 23-28, and 30-34.

DECISION

The rejection of claims 1, 3, and 5-28 under 35 U.S.C. § 101 is AFFIRMED.

The rejections of claims 1, 3, and 5-34 under 35 U.S.C. § 103(a) is REVERSED.

This decision contains new rationales of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

hh